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| 10/047,817 | 01/15/2002 | Richard Allen Brown | 214967 | 4741 |

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| EXAMINER | |
|---|---|
| JIANG, SHAOJIA A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1617 | |

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/047,817 | BROWN, RICHARD ALLEN | |
| | Examiner | Art Unit | |
| | Shaojia A Jiang | 1617 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-9,11-32 and 52-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-32 and 52-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on February 24, 2004 wherein claims 1-9 and 11-32 have been amended since claim 1 has been amended; claims 52-58 are newly submitted; claims 10 and 33-51 are cancelled.

Currently, claims 1-9, 11-32, and 52-58 are pending in this application.

Claims 1-9, 11-32 as amended now and new claims 52-58 are examined on the merits herein.

Applicant's remarks filed on February 24, 2004 with respect to the rejection of claims 1-32 and 52 made under 35 U.S.C. 112 second paragraph for the use of the indefinite recitations, i.e., "a pigment", "an emulsifier", "a sunscreening agent", "a thickener", "an alcohol", and "a preservative" of record stated in the Office Action dated October 20, 2003 have been fully considered and found persuasive to remove the rejection. Therefore, the said rejection is withdrawn.

Applicant's amendment filed on February 24, 2004 changing the limitation to a the specific emulsifier, cetyl dimethicone copolyol in claim 1 with respect to the rejection of claims 1-4 and 7-32 made under 35 U.S.C. 102(b) as being anticipated by Hollenbery et al. (US 5,143,722) for reasons of record stated in the Office Action dated October 20, 2003 have been considered and are found persuasive to remove this particular rejection. Therefore, the said rejection is withdrawn.

The following is new rejection(s) necessitated by Applicant's amendment filed on February 24, 2004.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 11-32, and 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenbery et al. (US 5,143,722, of record) in view of Guthauser (US 5162378, PTO-892).

Hollenbery et al. discloses cosmetic or make-up (i.e., a foundation, eyeliner) compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in amount about 30%, an aqueous phase for example 26% of water by weight which reads about 30%, a pigment herein and a sunscreening agent such as titanium dioxide (TiO2), an emulsifier broadly having HLB value from 2 to 12 in 0.25-2% by wieght, such as the surfactant therein (see col.6 lines 13-45) and a thickener such as quaternium-18 hectorite (see col.6 lines 60-67) in amount for example 0.5% by weight, an inorganic salt such as sodium chloride, and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane i.e., cyclomethicone in amount 22.6% for

example, prooylene glycol, and a preservative such as propyl paraben (see abstract, col.1-2, col.6 lines 11-68, Example 1-6 at col.7-8, and claims 1-15).

Hollenbery et al. does not expressly disclose the employment of the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions therein.

Guthauser discloses a water-in-oil emulsion composition for personal care comprising 8-20% of the particular emulsifier, cetyl dimethicone copolyol, having HLB value from 4 to 6 (see abstract, col.2 lines 30-39, and claim 1 in particular), 20-40% of water, 10-35% of silicone elastomer herein such as cyclomethione and phenyl dimethicone, 8-20% of inorganic salts, and 1-20 % of PEG (see claims 1-4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions of Hollenbery et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the particular emulsifier, cetyl dimethicone copolyol, in the water-in-oil emulsion compositions of Hollenbery et al, since an emulsifier broadly having HLB value from 2 to 12, is known to be used in the water-in-oil emulsion composition according to Hollenbery. The particular the particular emulsifier, cetyl dimethicone copolyol, is known to have HLB value from 4 to 6 according to Guthauser. Thus, cetyl dimethicone copolyol is a known and art-recognized emulsifier which can provide the HLB value as the water-in-oil emulsion composition of Hollenbery et al. desired to give water-in-oil emulsion. Therefore, one of ordinary skill in the art would

have reasonably expected that a known and art-recognized emulsifier, cetyl dimethicone copolyol, having HLB value from 4 to 6, would have the same or substantially similar usefulness as other emulsifiers therein in water-in-oil emulsion compositions of Hollenbery et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to optimize the amount of cetyl dimethicone copolyol to in 3-6% by weight, since the amount of an emulsifier in the water-in-oil emulsion compositions of Hollenbery et al. and the amount of cetyl dimethicone copolyol in Guthauser's water-in-oil emulsion composition are known in the art and closer to the claimed range herein. Thus, the determination or optimization of known amounts of a known emulsifier based on the prior art teachings, is considered well within conventional skills in the art, involving merely routine skill in the art.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-9, 11-32, 53-54, 56, and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Stepnieski et al. (US 5,599,533, of record).

Stepnieski et al. discloses cosmetic compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in the instant amount (see col.2 line 56 to col.3 line 18), an aqueous phase in the instant amount (see col.4 lines 55-58), a pigment herein, vitamin A and E, a sunscreening agent broadly and pigments broadly such as titanium dioxide (TiO2) and a preservative (see col. 4 line 4 to col.5 .line 7), an emulsifier or surfactants having HLB of 2-6 broadly in 0.01-20% or 0.1-4 % by weight (see col.2 lines 29-35), or the particular emulsifier or surfactant, cetyl dimethicone copolyol in 0.5% by weight (see col.4 27-28 and col.5 Example 1) and a thickener such as such as quaternium-18 hectorite in the instant amount (col.3 lines 45-65 and col.4 line 4), and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane in the instant amount, i.e., cyclomethicone (see col.2 lines 19-45), prooylene glycol and an inorganic salt such as sodium chloride (see col.3 lines 51-61). See also abstract, Example 1-6 at col.5-6, and claims 1-40.

Thus, the disclosure of Stepnieski et al. anticipates claims 1-4, 6-9, 11-32, 53-54, 56, and 58.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 55, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stepnieski et al. (US 5,599,533, of record) in view of Rapaport (US 5730991, PTO-892) and Dorogi et al. (US 5882661, PTO-892).

The same disclosure of Stepnieski et al. has been discussed in the 102(b) rejection set forth above (see supra).

Stepnieski et al. does not expressly disclose the employment of the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, the particular sunscreening agent herein and the particular preservative herein in the water-in-oil emulsion compositions therein.

Rapaport discloses that octyl methoxycinnamate is well known sun screening agent. See col.17 lines 20-25, col.19 line 10.

Dorogi et al. discloses that phenoxyethanol, propyl paraben and methyl paraben are preferred preservatives therein used in personal care or conditioning human skin, hair or nails compositions (see col.5 lines 17-18).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions of Stepnieski et al., and to

employ octyl methoxycinnamate as sun screening agent, and to employ phenoxyethanol, propyl paraben and methyl paraben as a preservative.

One having ordinary skill in the art at the time the invention was made would have been motivated to determine or optimize cetyl dimethicone copolyol to 3-6% by weight, since an emulsifier or surfactants having HLB of 2-6 broadly in 0.01-20% or 0.1-4 % by weight is known according to Stepnieski et al. Hence, the claimed range 3-6% lies inside ranges disclosed by the prior art. Thus, a *prima facie* case of obviousness exists. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See also MPEP 2144.05.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ octyl methoxycinnamate as sun screening agent, and to employ phenoxyethanol, propyl paraben and methyl paraben as a preservative, since sun screening agent and a preservative broadly, are known to be used in the water-in-oil emulsion composition according to Stepnieski et al. The particular sun screening agent, octyl methoxycinnamate, and phenoxyethanol, propyl paraben and methyl paraben as preservatives are well-known in the art to be used in personal care or conditioning human skin, hair or nails compositions Therefore, one of ordinary skill in the art would have reasonably expected that a known and art-recognized sun screening agent, octyl methoxycinnamate, and preservatives such as phenoxyethanol, propyl paraben and methyl paraben, would have the same or substantially similar usefulness as other sun screening agents and preservatives in water-in-oil emulsion compositions of Stepnieski et al.

Applicant's arguments filed on February 24, 2334, with respect to the pariro art rejections of record in the previous Office Action have been considered but are moot in view of the new ground(s) of rejection above.

Additionally, the record contains no clear and convincing evidence of nonobviousness or unexpected results for the combination method herein over the prior art. In this regard, it is noted that the specification provides no side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
April 29, 2004